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58

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 08/650,709 | 05/20/96 | ALBIN D | 7693-002-0 |

022850
OBLON SPIVAK MCCLELLAND MAIER & NUESTADT
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON VA 22202

QM32/0907

| EXAMINER | |
|---|---|
| DEXTER, C | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3724 | 34 |

**DATE MAILED:** 09/07/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Advisory Action

| Application No. | Applicant(s) |
|---|---|
| 08/650,709 | Albin et al. |
| **Examiner** | **Group Art Unit** |
| Clark F. Dexter | 3724 |

THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☐ expires _____ months from the mailing date of the final rejection.

b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

**Applicant's response to the final rejection, filed on** *Aug 6, 2000* **has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:**

☐ The proposed amendment(s):

- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☐ will not be entered because:
  - ☐ they raise new issues that would require further consideration and/or search. (See note below).
  - ☐ they raise the issue of new matter. (See note below).
  - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

☐ Applicant's response has overcome the following rejection(s):

_____

☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
*see attachment.*

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: *None*

Claims objected to: *None*

Claims rejected: *17, 19, 21, 22, 26, and 27*

☒ The proposed drawing correction filed on *Mar 22, 2000* ☐has ☒has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ .

☐ Other

**CLARK F. DEXTER**
**PRIMARY EXAMINER**
**ART UNIT 3724**

**ATTACHMENT TO ADVISORY ACTION (paper #34)**

***Response to Arguments***

1. Applicant's arguments filed August 6, 2000 have been fully considered but they are not persuasive.

Prior Art:

Applicant's arguments on pages 1-2 directed to the prior art rejections to Johnson et al. have been considered but are not persuasive. Johnson et al. clearly discloses a conveying device (e.g., 14). Further, the form of the limitation does not automatically invoke 35 USC 112, 6th paragraph, and applicant has not stated that the limitation should be interpreted as invoking 35 USC 112, 6th paragraph. Thus, the recitation "driven to convey ..." has been interpreted as a functional recitation of intended use of the disclosed structure of Johnson et al., and thus the recitation is met by Johnson since Johnson's conveying device (e.g., 14) can clearly be driven, for example, by hand, at any speed including a speed sufficiently less than the circumferential speed of the cutting roll.

Applicant's arguments on page 2 directed to the prior art rejections to Heywood in view of Williams have been considered but are not persuasive. The Examiner agrees that Heywood alone does not meet the claimed invention because the conveyor (e.g. L) of Heywood could not perform the recited functional recitation of intended use (i.e., convey the workpiece at a speed sufficiently less that the circumferential speed of the cutter roller). However, it is the Examiner's

position that the claims, which are directed to an apparatus and not a process, merely require a conveying device which is separately driven from the cutter roll and thus can be driven at any speed independent of the cutter roller. The issue that the conveying speed is less that the speed of the cutter roll is considered an intended use and is of little patentable moment. Williams along with Heywood teaches the claimed invention since Williams discloses a separate, independently-driven conveying device (e.g., carrier belt 5) for moving material onto a conveyor. That is, the carrier belt of Williams would be placed upstream of the conveyor of Heywood to feed the conveyor of Heywood and thus to the nip of Heywood. It is further noted that there is no specific positional relationship required between the conveying device and the nip. Further, even if it is argued that the conveying device must be upstream of the nip in order to feed material to the nip, there is no requirement that the conveying device be adjacent the nip. Thus, the Examiner's position is that a conveying device which is independently driven and upstream of the entire device of Heywood (including its conveyor L) meets the claimed invention. Further, if it is argued that the prior art must teach the conveying device being driven at the slower, claimed speed, the Examiner's position is that such is old and well known in the art for the reasons stated in the prior art rejection.

112, 1st Paragraph:

Applicant's statement at the bottom of page 2 directed to the rejection under 35 USC 112, 1st paragraph, is accurate and this rejection has been obviated.

112, 2nd Paragraph:

Applicant's argument at the top of page 3 directed to the rejection under 35 USC 112, 2nd paragraph is not persuasive, and it is suggested in line 9 to insert --disposed upstream from said nip and-- after "device" or the like.

Drawings:

Applicant's arguments on page 3 directed to the drawings are not persuasive because, although applicant states that the original disclosure (on page 11, line 12) describes "notches" in the surface of the back-up roll, there is no support for the specific notch/roll surface configuration shown in the proposed new figure. Because there appears to be no support in the original disclosure for the specific notch/roll surface configuration shown in the new figure, it appears that applicant has two options to obviate this matter: (1) amend the specification to state notch configurations are old and well known in the art and that one such configuration is shown in the new figure (i.e., Figure 5); or (2) delete the limitations directed to the notch (i.e., depressions).

cfd
September 1, 2000